REMARKS

The application has been reviewed in light of the Office Action dated July 3, 2007 and a telephone interview on Wednesday, August 22, 2007 between Examiner Hashem and Applicant's representative Jay Ryan. In that telephone interview, Examiner Hashem indicated that the present amended claims appear significantly different from the previously presented claims. This communication is believed to be a full and complete response to the aforementioned Office Action.

Claims 1-9 and 11-20 were pending in the present application prior to entry of the present amendments. By the present Office Action Claims 1-9 and 11-20 have been rejected. By the present amendment, Claims 1, 2, 3, 5, and 12 have been amended. Claims 4, 6-9 and 11-20 also remain in the application, and upon entry of the present amendment, Claims 1-9 and 11-20 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

I.   SUMMARY OF CLAIM AMENDMENTS

Claims 1, 2, 3, 5, and 12 are amended. The amendments to Claims 1 and 12 are described in detail below.

II. CLAIM REJECTIONS

Under 35 U.S.C. § 112

Claim 5 was rejected in the Office Action under 35 U.S.C. 112, second paragraph, as the term "the second destination" was held to lack antecedent basis. Applicant believes that the amendment made to claim 5 have rendered this ground of rejection moot. Applicant therefore respectfully requests reconsideration and withdrawal thereof.

Under 35 U.S.C. § 103

Claims 1-4, 6-11, 12-17, 19 and 20 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,580,784 to *Rodriguez et al.* in view of U.S. Patent No. 6,203,192 to *Fortman*. Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

The Examiner has the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. 103(a). Recently, the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed. In response, the Deputy Commissioner for Patent Operations issued a memorandum that states: "**Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the**

manner claimed." *USPTO Memorandum*, dated May 3, 2007, Focarino, M. (emphasis in original).

Also, the Federal Circuit has held that it is improper to modify a reference in a way that destroys the intent, purpose, or function of the invention disclosed in the reference. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). For these reasons and others as discussed below, the Office Action has failed to present a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, "it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." *USPTO Memorandum* citing, *KSR*, 127 S. Ct. at 1740-41.

Rodriguez et al. relates to a system and method for notifying an unavailable receiver of an urgent phone message. *Rodriguez et al.* discloses sending an urgent message to one or more alternate locations stored in a user profile (*See, e.g.*, col. 6, line 66 through col. 7, line 22). The alternate location can be an alphanumeric pager or an email address, which respectively generate a digital message or an email message informing the user of the urgent phone message. (*See, e.g.*, col. 7, lines 22-50). In either case, Rodriguez *et al.* simply discloses that these notifications can include "even the contents of the message using speech recognition software." (*See, e.g.*, col. 7, lines 34-36 and 48-49.)

The Office Action admits that *Rodriguez et al.* fails to disclose storing information in a database including formatting information associated with each type of alternate destination device. To supply this deficiency, a combination with *Fortman* is proposed. *Fortman* discloses a system having a number of translator components for receiving messages in different formats and translating these messages into text that can be received by a subscriber's telecommunications equipment. For example, a voice translator 5100 translates a voice message

into ADSI text format. A fax graphics translator 5200 translates the graphics of a fax transmission into ADSI text format. A text translator 5300 translates text messages into ADSI text format. A miscellaneous translator 5400 translates from other non-specified types of messages into ADSI text format (*See, e.g.*, col. 3, line 53 through col. 5, line 28). *Fortman* also mentions that the subscriber can use other types of telecommunications equipment capable of receiving text, such as GSM, an internet terminal, or a facsimile machine (*See, e.g.*, col. 6, line 59 through col. 7, line 30). In all instances, only a <u>single type</u> of subscriber telecommunications equipment is indicated for receiving messages.

Applicant respectfully submits that, as detailed below, the cited references fail to disclose or suggest each and every element as set forth in independent Claims 1 and 12, and as a matter of law, those claims that depend therefrom, in order to render the claims unpatentable in accordance with 35 U.S.C. § 103.

A. The Independent Claims

Claim 1 as currently pending is reproduced below:

Claim 1. A method of routing a text message to an alternate destination associated with a called party where a first destination is unavailable comprising the steps of:

storing and maintaining *a database of information **provided by the called party*** including:

a plurality of alternate destinations associated with a plurality of different types of alternate destination devices;

*routing information **corresponding to each alternate destination;** and*

*text formatting information associated with **each of the plurality of different types of alternate destination devices***;

receiving a call to the first destination associated with a called party initiated by a calling party, wherein the first destination is unavailable;

based on the unavailability of the first destination, requesting a voice message from the calling party;

receiving the voice message provided by the calling party;

converting the voice message into a text message;

searching the database **to locate routing information and text formatting information particular to at least one alternate destination device selected by the called party**;

retrieving **the routing information and the text formatting information from the database for the selected alternate destination device** *associated with the alternate destination of the called party*;

formatting the text message in the text format required by the at least one selected alternate destination device; and

forwarding the formatted text message to the alternate destination associated with the selected alternate destination device *of the called party.*

Applicant respectfully submits that the proposed combination of *Rodriguez et al.* and *Fortman* does not include at least the features of Claim 1 highlighted above. Specifically, it is noted that the passages of these references cited in the Office Action, taken alone or in combination, fail to disclose or suggest at least the features of amended Claim 1 highlighted above.

With regard to the *Rodriguez et al.* reference, the Office Action cites col. 3, lines 35-45. This passage supports Fig. 1a and merely discloses that a caller dials a phone

number, and that when an unavailable receiver does not answer, a telephone answering system answers and prompts the caller for a message and a priority. The cited passage at col. 4, line 44 through col. 5, line 30 supports the flowchart of Fig. 2 and simply discloses steps of a method where a caller is prompted to leave a voice message with a voice mail system that stores a caller's message and a priority corresponding with the message. An embodiment is indicated where a caller ID is used to determine whether particular callers should be treated as urgent or as a normal caller. Alternatively, another embodiment allows callers to enter their own priority. Another lengthy passage is cited at col. 6, line 66 through col. 8, line 3 that supports the flowchart of Fig. 4. This passage discloses that the voice mail system forwards urgent messages to one or more user-specified alternate phone numbers, which are stored in a user profile, which is a file or database. If the forwarding address is an alphanumeric pager or an email address, a variety of information can be included such as the date and time of the message, the caller ID information corresponding to the caller that left the message, and even the contents of the message using speech recognition software.

It should be carefully noted that neither the above-referenced passages, nor the remainder of the reference disclose or suggest any additional details. It must therefore be noted that the "user profile" of *Rodriguez et al.* is simply disclosed as being a list of <u>alternate destinations</u>. There is no mention in this reference of any sort of "text formatting" for the "contents of the message" generated using speech recognition software. There is no disclosure or suggestion in the four corners of *Rodriguez et al.* of a database that includes *text formatting information associated with each of the plurality of different types of alternate destination devices*, as recited in claim 1. Therefore,

Rodriguez et al. cannot be relied upon to disclose or suggest the other steps recited in claim 1, including: *searching the database to locate routing information and text formatting information; retrieving the routing information and the text formatting information from the database for the selected alternate destination device; formatting the text message in the text format required by the at least one selected alternate destination device;* and *forwarding the formatted text message to the alternate destination associated with the selected alternate destination device of the called party.*

As noted hereinabove, the Office Action admits that *Rodriguez et al.* fails to disclose storing in the database information including formatting information associated with each type of alternate destination device. Thus, combination with *Fortman* is proposed. However, as pointed out hereinabove, the *Fortman* system simply discloses a number of translator components for receiving messages in different formats and translating these messages into text that can be received by a subscriber's telecommunications equipment. To wit, the Office Action cites a lengthy passage of *Fortman* from col. 3, line 53 through col. 5, line 28. This passage simply discloses a voice translator 5100, a fax graphics translator 5200, a text translator 5300 and a miscellaneous translator 5400 which each respectively translate voice, fax graphics, text and anything else into ADSI text format readable by the subscriber's telecommunications equipment. As disclosed in the cited passage at col. 6, line 59 through col. 7, line 30, *Fortman* alternatively mentions that the subscriber can use other types of telecommunications equipment capable of receiving text, such as GSM, an internet terminal, or a facsimile machine.

It should be carefully observed that in all instances disclosed by *Fortman*, a plurality of different types of inputs are translated so as to be viewable on a single type of subscriber telecommunications equipment for receiving messages. This is precisely the opposite of the claimed invention in which a single type of input is presented in a selected text format associated with each of a plurality of different types of destination devices corresponding to a plurality of alternate destinations. It is also noted that there is nothing disclosed or suggested in *Fortman* relating to a ***database*** that includes ***text formatting information*** *associated with* ***each of the plurality of different types of alternate destination devices.*** Therefore, *Fortman* cannot be relied upon for supplying the steps of *searching, retrieving, formatting* and *forwarding* shown hereinabove to be lacking in the *Rodriguez et al.* reference. Thus, it is readily apparent that *Fortman* fails to shore up the deficiencies of *Rodriguez et al.* and even if these references were somehow combinable as proposed, they would still nevertheless fail to disclose the invention as recited in amended Claim 1.

In view of at least the aforementioned reasons, it is readily apparent that the proposed combination of *Rodriguez et al.* and *Fortman* fails to disclose or suggest each and every aspect of claim 1. Therefore, the proposed combination fails to meet the requirements for obviousness as set forth in 35 U.S.C. § 103. Applicant therefore respectfully requests that the rejection of Claim 1 and dependent Claims 2-4, 6-9, and 11 be withdrawn.

Claim 12 as currently pending is reproduced below:

Claim 12. A system for routing a text message to an alternate destination associated with a called party where a first destination is unavailable comprising:

a first switch for receiving a call to a first destination associated with a called party initiated by a calling party, wherein the first destination is unavailable;

a network element, coupled to the first switch, for requesting a voice message from the calling party based on the unavailability of the first destination and receiving the voice message provided by the calling party; and

a voice recognition means, coupled to the network element, for converting the voice message to a text message based on determining an appropriate text format required by the alternate destination;

a database *for retaining and selecting information provided by the called party including a plurality of alternate destinations associated with a plurality of different types of alternate destination devices,* and routing information associated with each type of alternate destination communication device, the routing information for each communication device including:

a list of directory numbers for corresponding alternate destination communication devices;

formatting information *for the corresponding alternate destination communication devices, the formatting information comprises* *an appropriate text format required for each communication device selectable as the alternate destination* *and retrieved by the voice recognition means; the system further comprising

a second switch, coupled to the network element, wherein *the network element forwards the appropriately formatted text message to at least one alternate destination selected by the called party* via the second switch.

Applicant respectfully submits that the combination alleged in the Office Action to make obvious the present invention does not include at least the features of Claim 12 highlighted above. As mentioned *supra* with respect to Claim 1, the combination of *Rodriguez et al.* and *Fortman* fails to disclose or suggest a system that employs ***a database*** *for retaining and selecting information provided by the called party including a plurality of alternate destinations associated with a plurality of different types of alternate destination devices,* and also *routing information associated with each type of alternate destination communication device* including ***formatting information*** *for the corresponding alternate destination communication devices* that comprises ***an appropriate text format required for each communication device selectable as the alternate destination.*** As pointed out hereinabove with respect to Claim 1, there is no disclosure or suggestion in the four corners of *Rodriguez et al.* a ***database*** that includes ***text formatting information*** *associated with* ***each of the plurality of different types of alternate destination devices.*** Further, it has been shown hereinabove that *Fortman* simply discloses a system in which a <u>plurality of different types</u> of inputs are translated so as to be viewable on a <u>single type</u> of subscriber telecommunications equipment for receiving messages. As already mentioned, this is <u>precisely the opposite</u> of the claimed invention in which a <u>single type of input</u> is presented in a <u>selected text format</u> associated with each of a <u>plurality of different types of destination devices</u> corresponding to a plurality of alternate destinations. It has also been noted hereinabove that *Fortman* fails to disclose or suggest a ***database*** that includes ***text formatting***

*information associated with **each of the plurality of different types of alternate destination devices.*** For at least this reason, *Fortman* cannot be relied upon to shore up the deficiencies of *Rodriguez et al.* Therefore, even if these references were somehow combinable as proposed, they would still nevertheless fail to disclose the invention as recited in amended Claim 12.

For at least these aforementioned reasons, Applicant respectfully requests that the rejection of Claim 12 and dependent Claims 13-17, 19, and 20 be withdrawn.

Under 35 U.S.C. § 103(a)

Claims 5 and 18 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over *Rodriguez et al.* in view of *Fortman* and further in view of U.S. Patent No. 6,085,231 to *Agraharam et al.* Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.
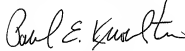
Claim 5 depends from Claim 1, and Claim 18 depends ultimately from Claim 12, which as described above are patentable over *Rodriguez et al.* in view of *Fortman.* Applicant submits that *Agraharam et al.* does not add any features that cure the deficiencies of the proposed combination of *Rodriguez et al.* and *Fortman.* Therefore claims 5 and 18 are also allowable over the cited art for at least the same reasons as the independent claims from which they depend. Applicant therefore respectfully requests that the rejection be withdrawn.

III. CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed July 3, 2007. Applicant thanks Examiner Hashem for her consideration of these amendments. Applicant respectfully submits that the pending claims, as amended, are patentable over the cited references, and a Notice of Allowance indicating the same is respectfully requested. The preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

If Examiner Hashem believes any issues remain that can be resolved by a telephone conference, or there are any informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at the number listed below to discuss the same is respectfully requested.

Respectfully submitted,

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